

REMARKS

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Benazzi (WO 01/81508) in view of Biscardi (U.S. 6,579,441) (hereinafter the '441 patent). Applicants respectfully traverse this rejection based on the claims as currently amended. The Benazzi reference is in French and the response to this office action refers to the US equivalent of that patent, U.S. 6,884,339 (hereinafter the '339 patent).

Claim 1 claims a process for the preparation of medicinal white oil or a technical white oil from a Fischer-Tropsch derived paraffinic distillate bottom product, comprising contacting the bottom product with a heterogeneous adsorbent.

The '339 patent describes an "improved process for the production of very high quality base oils, i.e., that have a high viscosity index (VI), a low content of aromatic compounds, good UV stability and a low pour point, from petroleum fractions that have a boiling point of greater than 340°C." Col. 1, lines 4-9. The patent teaches that with "a judicious selection of operating conditions [it is] possible to obtain white medicinal grade oils." Col. 1, lines 65-67. The process described has six steps: hydrotreatment, hydrocracking, atmospheric distillation of the effluent, catalytic dewaxing, hydrofinishing and a distillation step comprising atmospheric distillation and vacuum distillation. *See* Col. 2, lines 6-59.

The '441 patent describes "a lubricating oil base stock and . . . a sorption process for dehazing a base oil feed to produce the lubricating oil base stock." Col. 1, lines 18-20. The patent teaches that the "process is useful for treating streams characterized by a wide range of boiling points [including] diesel feed, waxy middle distillate, lube oils, gas oils and vacuum gas oils, white oils and the like." Col. 5, lines 12-16. The patent also teaches the use of "synthetic oils such as those [made] by Fischer-Tropsch synthesis." Col. 5, lines 26-27. The "preferred oil supplied as feed to the . . . process is a catalytically dewaxed base oil" having certain cloud and pour points. Col. 6, lines 12-14.

The Examiner alleges that a person having ordinary skill in the art of processes for the preparation of medicinal and/or technical white oils would have been motivated to combine the process of Benazzi with the adsorption treatment process of Biscardi.

Additionally, the Examiner alleges that a person of ordinary skill in the art would have had a reasonable expectation of success in combining the process of Benazzi with that of Biscardi. The Applicant submits that the Examiner is incorrect as further explained below.

The '339 patent teaches a process for converting a feedstock into a medicinal white oil that comprises six steps. The '339 patent teaches that after the catalytic dewaxing step, the effluent is passed through a hydrofinishing step and then separated by distillation to produce the medicinal white oil. As described in the '339 patent and in the specification of the current application, a medicinal white oil must meet certain specifications related to color and UV absorbance.

The '441 patent states that "[i]t will be immediately obvious to the skilled practitioner that the temperature for removing the haze in the present process is much less than the temperatures used in commercial operations for reducing color from oil using a solid sorption process." Col. 8, lines 56-60. The '441 patent is directed to removing haze, and the only reference to color appears in Example 9 and shows that the Saybolt color required to meet the specification of a medicinal white oil is not met by the process taught in the '441 patent.

It is clear that there are two different problems being addressed by the cited references. The '339 patent is directed to producing high quality lubricating oils, including medicinal white oils. The '441 patent, on the other hand is directed to reducing haze in lubricating oils, and based on the above discussion one of ordinary skill in the art would not have combined the two processes to produce a medicinal white oil. The combination of references does not provide a reasonable expectation of success because the '441 patent teaches away from using the adsorption step for reducing color which is one of the key specifications in producing technical or medicinal white oils.

In light of the above, the Applicant respectfully requests allowance of the claims as previously presented in this application. Should the Examiner find any impediment to the allowance of this case that could be corrected by a telephone interview, the Examiner is requested to initiate such an interview with the undersigned.

Respectfully submitted,

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